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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/623,705

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Joerg Schwan

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05/28/2009

SCHWEGMAN, LUNDBERG & WOESSNER/SAP

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EXAMINER

BOYCE, ANDRE D

ART UNIT

PAPER NUMBER

3623

NOTIFICATION DATE

DELIVERY MODE

05/28/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/623,705	<b>Applicant(s)</b> SCHWAN ET AL.	
	<b>Examiner</b> Andre Boyce	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Amendment***

1. This Final office action is in response to Applicant's amendment filed February 12, 2009. Claims 1-28 are pending.
2. Applicant's arguments filed February 12, 2009 have been fully considered but they are not persuasive.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to independent claim 1, the claim language recites the steps of defining instructions to implement the change, associating a first validity, associating a second validity and automatically implementing, however the claim language does

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not include the required tie or transformation. Moreover, the claim recites "computer-implemented" in the preamble, however this is considered a nominal tie that does not satisfy the requirement, wherein a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hiraio*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 2-14 are rejected based upon the same rationale, wherein the claim language does not include the required tie or transformation.

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Matheson (USPN 6,944,514).

As per claim 1, Matheson discloses a computer-implemented method for managing a change to a product structure (i.e., innovation information management, including an engineering change, column 5, lines 9-25) comprising: defining instructions to implement the change to the product structure (i.e., product requirements 120, column 5, lines 26-30); associating a first validity for the change with a first organizational structure, the first organizational structure having a first

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organizational view of the product structure (i.e., requirements from many sources, e.g., marketing, customers, engineering, manufacturing, column 5, lines 26-30); associating a second validity for the change with a second organizational structure, the second organizational structure having a second organizational view of the product structure (i.e., requirements from many sources, e.g., marketing, customers, engineering, manufacturing, column 5, lines 26-30); and automatically implementing the change according to the first validity for the first organizational view, and according to the second validity for the second organizational view (i.e., product requirement interface allows tracking of all decisions related to the product requirements, column 7, lines 7-10).

As per claim 2, Matheson discloses defining instructions to change a plurality of different objects of the product structure (i.e., object model 100, column 5, lines 15-20).

As per claim 3, Matheson discloses at least one of the first and second validities depends on a date (i.e., data may be created automatically, including creation time of last modified date, column 8, lines 47-57).

As per claim 4, Matheson discloses at least one of the first and second validities is valid beginning with a first date and ending with a second date (i.e., data may be created automatically, including creation time of last modified date, column 8, lines 47-57).

As per claim 5, Matheson discloses a hierarchy of organizational structures and wherein the second validity depends on the first validity (i.e., each product idea may

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have various associated product requirements which may have associated product function objects, column 5, lines 53-61).

As per claim 6, Matheson discloses at least one of the first and second validities depends on attaining a production milestone (i.e., product requirement 120 the product must fulfill, column 5, lines 26-30).

As per claim 7, Matheson discloses at least one of the first and second validities depends on implementing a different change to the product structure (i.e., requirements from many sources, e.g., marketing, customers, engineering, manufacturing, column 5, lines 26-30).

As per claim 8, Matheson discloses a previous validity is associated with the change and wherein defining instructions to implement the change includes defining instructions for modifying the previous validity (i.e., innovation information management, including an engineering change, column 5, lines 9-25).

As per claim 9, Matheson discloses the change includes previous instructions for changing the product structure and wherein defining instructions to implement the change includes defining instructions for modifying the previous instructions (i.e., innovation information management, including an engineering change, column 5, lines 9-25).

As per claim 10, Matheson discloses the first validity precedes the second validity (i.e., each product idea may have various associated product requirements which may have associated product function objects, column 5, lines 53-61).

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As per claim 11, Matheson discloses the second validity is dependent upon the first validity and contemporaneous with the first validity (i.e., each product idea may have various associated product requirements which may have associated product function objects, column 5, lines 53-61).

As per claim 12, Matheson discloses storing the instructions to implement the change to the product structure, the first validity, and the second validity in a first database, wherein the product structure is stored in a second database, the second database being separate from the first database (i.e., separate relational database file defined for each defined interface, column 7, lines 34-50).

As per claim 13, Matheson discloses receiving a request to make a change to a product structure (i.e., innovation information management, including an engineering change, column 5, lines 9-25).

As per claim 14, Matheson discloses determining whether the change should be implemented (i.e., decisions related to product requirements and product function, column 7, lines 5-7); generating a change order to implement the change, the change order including the instructions to implement the change of the product structure, the first validity, the second validity (i.e., innovation information management, including an engineering change, column 5, lines 9-25), and a name of a user who determined that the requested change should be implemented (i.e., user access via appropriate permissions, column 4, lines 49-55); and storing the change order in a first database, wherein the product structure is stored in a second

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database, the second database being separate from the first database (i.e., separate relational database file defined for each defined interface, column 7, lines 34-50).

Claims 15-28 are rejected based upon the same rationale as the rejections of claims 1-14, respectively, since they are the computer program product claims corresponding to the method claims.

### ***Response to Arguments***

7. In the Remarks, with respect to the 35 USC §101 rejection, Applicant argues that claim 1 meets the transformation test because the "product structure" data represent a physical object, namely a product, and the claimed method transforms ("automatically implements the change") that data. The Bilski test does not require that the underlying physical object itself be transformed; transforming representative data is sufficient. The Examiner respectfully disagrees. Here, as seen in Applicant's specification (pages 4-5), the product structure is simply "...a variety of documents, such as a specification document 230, a computer aided design ("CAD") document 240 and a Parts/Materials document 250." As such, these documents are merely a parts listing and are not analogous to the X-ray attenuation data discussed in *In Re Abele*, 684 F.2d 902 (C.C.P.A. 1982), wherein the "...data clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues." As a result, Applicant's claims do not satisfy the transformation prong of the machine-or-transformation test.



With respect to claim 1, Applicant argues that Matheson does not describe or suggest associating a first validity for the change with a first organizational structure, the first organizational structure having a first organizational view of the product structure; associating a second validity for the change with a second organizational structure, the second organizational structure having a second organizational view of the product structure; and automatically implementing the change according to the first validity for the first organizational view, and according to the second validity for the second organizational view.

The Examiner once again respectfully disagrees. Matheson discloses associating a first validity for the change with a first organizational structure, the first organizational structure having a first organizational view of the product structure (i.e., requirements from many sources, e.g., marketing, customers, engineering, manufacturing, column 5, lines 26-30); associating a second validity for the change with a second organizational structure, the second organizational structure having a second organizational view of the product structure (i.e., requirements from many sources, e.g., marketing, customers, engineering, manufacturing, column 5, lines 26-30); and automatically implementing the change according to the first validity for the first organizational view, and according to the second validity for the second organizational view (i.e., product requirement interface allows tracking of all decisions related to the product requirements, column 7, lines 7-10). As a result, Matheson indeed discloses an enhancement or improvement to an existing product (i.e., change, column 5, lines 21-25) that has to fulfill a plurality of requirements (i.e.,

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validity) from various organization structures (i.e., marketing, customers, engineering, manufacturing).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571)272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andre Boyce/  
Primary Examiner, Art Unit 3623  
May 22, 2009